

### REMARKS

This amendment and reply is in response to the Office Action dated March 17, 2008. Applicants have amended claim 16 and cancelled claim 58. No new matter is added. In amending the claim, Applicants do not concede that the claim as originally presented or previously amended is unpatentable over the references cited in the Office Action and reserve the right to pursue the previously presented claim in one or more continued applications. Claims 16-19 and 42-57 are presented for examination. In view of the foregoing amendment and the following remarks, Applicants request entry of the claim amendment and reconsideration and withdrawal of the rejections.

#### § 112 Rejection

Claim 58 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants have cancelled claim 58, thereby obviating the rejection.

#### § 103 Rejections

Claims 16-19 and 42-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,083,487 (Biel) in view of U.S. Patent No. 6,187,289 (Richards-Kortum). Claim 58 has been cancelled without prejudice, thereby obviating the rejection with respect to that claim. Claim 16, as amended, is directed to a method of identifying a characteristic of a region of a tissue sample comprising, *inter alia*, obtaining at least one reflectance signal from the region of the tissue sample within an optimal window of time, wherein the optimal window of time comprises a period of peak whitening in reflectance data or peak darkening of fluorescence of tissue. Neither Biel nor Richards-Kortum disclose or give reason to obtain a reflectance signal and fluorescence signal during a period of peak whitening in reflectance data or peak darkening in fluorescence tissue, as required. Richards-Kortum only teaches presentation of images in real time, and is silent as to the time period of obtaining spectral data with regard to periods of peak whitening or darkening after application of the contrast agent. (See Richards-Kortum at Col. 4, lines 42-50). Biel only discloses a period of up to ten minutes after application of the contrast agent before obtaining spectral data, but is also silent as to optimizing the data collection time by

concentrating on the window of time having peak whitening or darkening. (See Biel at Col. 2, lines 23-28). Applicants respectfully request reconsideration and withdrawal of the rejection with regard to claim 16.

Claims 17-19 and 42-57 are dependent on claim 16 and should be allowable for at least the same reasons as discussed above. Applicants respectfully request reconsideration and withdrawal of these rejections.

#### Double Patenting Rejections

Claims 16-19 and 42-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,933,154. Applicants do not necessarily agree with these rejections, but to obviate the rejections, Applicants may submit an appropriate terminal disclaimer upon indication that the claims are otherwise allowable, and respectfully request the rejections be held in abeyance until such indication that the claims are otherwise allowable.

#### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant : Schomacker, et al.  
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Petition for Extension of Time are being filed concurrently herewith. Please apply any other charges or credits to deposit account 06 1050.

Respectfully submitted,

September 17, 2008  
Date: \_\_\_\_\_

/Richard P. Ferrara/

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